

REMARKS

Claims 1-28, 66-71 and 75-102 are pending in the present application. Claims 16, 17, 24, 25, 91, 92, 99 and 100 are presently withdrawn from consideration. Claims 1-15, 18-23, 26-28, 66-71, 75-90, 101 and 102 stand rejected for the reasons indicated in the Office Action. In response, claims 4 and 79 have been canceled, and claims 1, 27, 66, 70, 75 and 101 have been amended. Support for these amendments can be found in the application as originally filed at page 8, lines 7-8, among other places. No new matter is added by these amendments. Entry of these amendments is hereby requested.

With Respect to the Amendments to Claims 27, 70 and 101:

Claims 27, 70 and 101 have been amended to correct minor grammatical errors. These amendments are not being made for reasons of patentability.

With Respect to the Rejections under 35 U.S.C. §102(b), Paragraph 5 of the Office Action:

Claims 1-8, 10, 18, 28, 66-69, 71, 75-83, 85, 93 and 102 stand rejected under 35 U.S.C. §102(b) as anticipated by United States Patent 4,394,470 to Werner et al., the Patent and Trademark Office stating that:

Werner et al. disclosed a method of injection molding PET containing carmelized or non-carmelized carbohydrates which fall within the scope of the instantly claimed polyols for the express purpose of limiting acetaldehyde formation in making bottles etc. See the abstract; column 1, lines 5-47; column 2, lines 5-16; column 3, lines 1-25, column 4, lines 1-9, column 5, line 5; and the remainder of the document. It is expected that the caramel retains OH groups but the saccharides added according to column 3, lines 12-13 will be the instantly claimed polyols.

The Applicant has reviewed the United States Patent 4,394,470. The entire text of the disclosure from the '470 related to acetaldehyde formation is as follows:

The colorant is non-toxic, does not affect the transparency of the polyester, and does not cause aldehyde formation. [abstract, second sentence]

Decomposition residues such as acetaldehyde, even in very small

quantities, are found to impart an undesirable taste to these foodstuffs. [column 1, lines 44-47]

For, acetaldehyde formation in the polyethylene terephthalate is found not to be greater than in the absence of caramel, which in view of the presence in the caramel of reactive components must be considered in unexpected factor. [column 2, lines 26-30]

Of polyethylene terephthalate respectively containing no and 4000 ppm of fructose the acetaldehyde content was determined before and after re-extrusion at 290.degree. C. on a single-screw 90 mm extruder. The moulding compound had been prepared in accordance with Example 2. The amounts of acetaldehyde are mentioned in Table 7.

TABLE 7

Fructose ppm	0	4000
acetald. content ppm		
before extrusion	1	1
after extrusion	8, 4	7, 9

It can be seen that the fructose caramelized in situ has no stimulating effect on the formulation of acetaldehyde, which formation in itself is due to the thermal degradation of the polymer. [column 6, lines 40-45]

Pending claims 1, 66 and 75 include the limitation that the amount of the "hydroxylic compound is present in an amount . . . sufficient to decrease the level of acetaldehyde in the molded article that would otherwise result without including the one or more than one polymer additive in the [thermoplastic molding] composition." As can be appreciated from the excepted text from the '470 Patent, there is no disclosure, whatsoever, of a hydroxylic compound that is present in an amount that is sufficient to decrease the level of acetaldehyde in the molded article that would otherwise result without including the one or more than one hydroxylic compound in the thermoplastic molding composition. At most, the '470 disclosure indicates that the additive disclosed does not increase the level of acetaldehyde formation. It is well-established law that a reference used as the basis for an anticipatory rejection under 35 U.S.C. §102(b) must have every limitation present in the rejected claim either explicitly or

inherently. Here, the '470 does not meet that requirement to serve as the basis for an anticipatory reference. Hence, no *prima facie* case of anticipation has been made.

Further, claims 1, 66 and 75 have been amended to recite that the "one or more than one hydroxylic compound is present in an amount from about 0.0001% to about 2% by weight of the polymer component." There does not appear to be any disclosure in the '470 as to the amount of the additive present in the thermoplastic molding composition itself, only disclosure as to the amount of the additive added BEFORE condensation. Hence, for this reason also, the '470 Patent does not anticipate the presently amended claims 1, 66 and 75.

Claims 4 and 79 have been canceled. Claims 2-3, 5-8, 10, 18, 28, 67-69, 71, 76-78, 80-83, 85, 93 and 102 are dependent on claims 1, 66 and 75. Therefore, withdrawal of these rejections is hereby requested.

With Respect to the Rejections under 35 U.S.C. §103(a), Paragraph 6 of the Office Action:

Claims 1-15, 18-23, 26-28, 66-71, 75-90, 93-98 and 101-102 stand rejected under 35 U.S.C. §103(a) as obvious over United States Patent 4,394,470 to Werner et al., in view United States Patent 5,863,964 to Teumac et al. and United States Patent 5,874,517 to Huang et al. for the reasons indicated in paragraph 6 of the Office Action.

As discussed above, the '470 Patent does not teach or suggest a composition comprising a "hydroxylic compound [that] is present in an amount . . . sufficient to decrease the level of acetaldehyde in the molded article that would otherwise result without including the one or more than one hydroxylic compound in the [thermoplastic molding] composition," nor does it teach or suggest that the "one or more than one hydroxylic compound is present in an amount from about 0.0001% to about 2% by weight of the polymer component" as recited in amended independent claims 1, 66 and 75. The other two references do not provide this teaching individually or together. Hence, the Applicant believes that a *prima facie* case of obviousness has not been established. Claims 4 and 79 have been canceled. Claims 2-3, 5-15, 18-23, 26-28, 67-71, 76-78, 80-90, 93-98 and 101-102 are dependent on claims 1, 66 and 75. Therefore, withdrawal of these rejections is hereby requested.

With Respect to the Withdrawn Claims and Priori Election of Species:

Claims 16, 17, 24, 25, 91, 92, 99 and 100 are presently withdrawn from consideration, and the species "dipentaerythritol" in response to paragraph A, and "bottle preform" in paragraphs B and C, and "hindered phenol" in paragraph D of the prior Restriction Requirement stand elected. For the reasons above, all pending claims, claims 1-15, 18-23, 26-28, 66-71, 75-90, 101 and 102 are now believed to be in condition for allowance. Therefore, the Applicant requests that the United States Patent and Trademark Office rejoin claims 16, 17, 24, 25, 91, 92, 99 and 100 and all previously non-elected species.

CONCLUSION

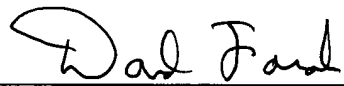
All pending claims, claims 1-3, 5-28, 66-71 and 75-78 and 80-102, are now believed to be in condition for allowance and an indication of such is hereby solicited. If any questions or issues remain regarding this application, the Examiner is requested to contact the undersigned to expedite resolution.

If any extension of time is required, such extension is hereby requested. The Commissioner is hereby authorized to charge payment of any fee associated with this communication, if such a fee is due, to Deposit Account No. 19-2090.

Respectfully submitted,

SHELDON & MAK
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